IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Enrique David Sancho	Examiner: John M. Winter
Serial No.:	09/500,601	Group Art Unit: 3685
Filed:	Feb 8, 2000	Docket No.: 2062.001US1
Title:	SYSTEM AND METHOD FOR SECURE NETWORK PURCHASING	
Assignee:	iPass Inc.	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant has reviewed the Office Action mailed on 03/02/2009. Please consider the following remarks. This response is accompanied by a Petition, as well as the appropriate fee, to obtain a one-month extension of the period for responding to the Office action, thereby moving the deadline for response from 03/10/09 to 04/10/10. 4/10/2010 fell on a weekend, moving the deadline for response with one-month extension to 4/12/2010.

§112 Rejection of the Claims

Claims 16-39 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 16 recites:

> receiving at least one response from the user computer, the at least one response including a first computer fingerprint file and a first identification for the user generated using the first computer fingerprint file, said first computer fingerprint file including at least one identifying characteristic associated with at least one hardware component of the user computer.

The Office asserts, "there is no corresponding step of generation, it is therefore unclear how the identification is obtained." Applicant disagrees, and submits that claim 16 is not indefinite. In claim 16, the first identification is obtained via receipt, from the user computer, of a response that includes *inter alia* the first identification for the user. Claim 16 further describes the "response" by indicating that the response's first identification was generated using the fingerprint file. Applicant need not add a "generating" operation, as the claim language is unambiguous. One of ordinary skill in the art would understand claim 16, as it is written. Claims 34-38 include language similar to that discussed above. Thus, Applicant submits claims 34-38 are not indefinite and allowable for at least the same reasons as discussed above.

§103 Rejection of the Claims

Claims 16-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padgett et al (US Patent 6,167,518) in view of Archibald et al. (US Patent5,825,883) and further in view of Klein (US Patent 6,857,076). Applicant submits that the rejected claims are patentable over the cited references because the cited references do not teach or suggest all elements of each rejected claim. Padgett, Archibald, and Klein are a hodgepodge of technical elements whose relationship to each other and the claims is tenuous. In the following discussion, Applicant will summarize the cited references and explain how the references do not teach or suggest all elements of each rejected claim. The following bullet points summarize each of the cited references:

- Padgett – Padgett describes a system for distributing digital certificates for use in authenticating documents. Padgett's digital certificates include digitized biological data (i.e., digitized chromosomal DNA) unique to particular users. If there is doubt about whether a given user transmitted a certificate-bearing message, Padgett's system can compare the user's biological data with the biological data in the certificate.[1]
- Archibald - Archibald's system tracks program usage on remote computers. Archibald's system includes one or more computers located remotely from a meter module. The meter module tracks use of software programs on the computers. The meter module includes a meter data file including the following information for tracking program usage on the computers: authority IDs that identify publishers of the programs, user IDs that identify computers and user accounts, and consumption IDs that identify particular usage of the programs. When a computer launches a program, the computer sends application information about the program usage to the meter module. The application information includes an application identifier identifying the program, publisher code identifying the program publisher, and an encryption key. After the meter module receives the application information, the meter module generates usage information that is used in a process for collecting money for the program usage.
- Klein – Klein describes methods for encrypting data on a computer's storage device, such as a hard disk drive. Klein's methods call for creating an encryption key based on a hardware identification code, and in some cases, user input. After generating the key, all data stored locally on the computer's hard disk drive (or other media device) is encrypted using the encryption key.

[1] See Padgett's Summary of the Invention at columns 2&3.

This Response will now discuss how the cited art does not teach or suggest all elements of the rejected claims. Claim 16 recites:

> receiving at least one response from the user computer, the at least one response including a first computer fingerprint file and a first identification for the user generated using the first computer fingerprint file, said first computer fingerprint file including at least one identifying characteristic associated with at least one hardware component of the user computer;
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> comparing the first computer fingerprint file, which includes at least one identifying characteristic associated with at least one hardware component of the user computer, against a second computer fingerprint file, to verify the user computer, the second computer fingerprint file accessible by the verification computer, said second computer fingerprint file including at least one identifying characteristic associated with at least one hardware component of the user computer;

In rejecting claim 16, the Office asserts that Archibald discloses claim 16's receiving a first fingerprint file and first identification for a user. The Office relies on Archibald's Figures 2 & 16 and its passage at column 6, line 36 to support this rejection. Applicant submits the Office Action has mischaracterized Archibald. Neither Archibald's user computer nor its meter module receive a fingerprint file that identifies a hardware component of the user computer. In contrast, Archibald's meter module is equipped with information for tracking program usage on the computers. The information includes authority IDs that identify publishers of the programs, user IDs that identify computers and user accounts, and consumption IDs that identify particular usage of the programs. Although Archibald's meter module includes user IDs that identify computers and user accounts, Archibald's user IDs differ from claim 16's fingerprint file. As recited in claim 16, the first fingerprint file includes "at least one identifying characteristic of at least one hardware component of the user computer." Archibald's user IDs does not include such information. Furthermore, Archibald's meter module does not receive user IDs from user computers. Instead, the meter module receives application information including an application ID and publisher ID. Based on the application and publisher IDs, the meter module looks-up User IDs in a local data store.

Also, in the "Response to Arguments", the Office indicated the following

> the claimed feature of "said first computer fingerprint file including at least one identifying characteristic associated with at least one hardware component of the user computer" does not restrict the "characteristic" to being a hardware identifier, since what is claimed is merely an "association" with the hardware. For example a data stamp generated by hardware would be sufficient to meet the claimed limitation. In the present rejection Archibald et al. ('883) discloses a meter identification file that is "associated" with a specific user via a meter identification code. (column 6, line 40), Archibald discloses receiving a data file (i.e., fingerprint file) comprising a user ID and a meter ID is based upon a

> characteristic of the meter. The Examiner submits that these features meet the limitations of the presently claimed invention.[2] (emphasis added)

Applicant respectfully traverses. First, "a data stamp generated by hardware" is not sufficient to meet the claimed limitation "identifying characteristic associated with at least one hardware component." A general "data" stamp generated by hardware does not specifically provide an identifying characteristic of the associated hardware component. For example, the stamp could be a stamp of any type of data (a characteristic of a software program executing on the hardware, a component stored in a database, etc.).

Further, in "Response to Arguments", the Office appears to equate "a meter identification file" associated with a specific meter via a meter identification code[3] (in Archibald) with "an identifying characteristic associated with a hardware component" (as recited in claim 16). However, "[t]he meter identification code 88 is used to identify this particular meter module 26."[4] This meter module is used to track software program usage on remote computers (see description above). As recited in claim 16, there is a comparing of the computer fingerprint files (that include the identifying characteristic associated with a hardware component). However, Archibald does not disclose or suggest the comparing of these meter identification codes 88 (which the Office is comparing with the identifying characteristic recited in claim 16). Thus, Archibald does not teach or suggest claim 16's operation for receiving or comparing of a fingerprint file. Also, in "Response to Arguments", the Office indicated that "upon comparing" is directed toward a conditional step and does "not narrow the claims because they can always be omitted. (citing MPEP 2106 IIC)."[5] Applicant respectfully traverses. The operation "sending" occurs in response to comparing not if the comparing occurs. Thus, this limitation is not conditional and does limit the claims.

The only way for the combination of Padgett, Archibald, and Klein to teach or suggest all the elements of claim 16 is for Klein to provide what the other references are lacking. However, Klein does not teach or suggest claim 16's receiving and comparing of fingerprint files. As noted above, Klein's method encrypts information on a local media device using an encryption key generated using a hardware identifier. However, Klein's method and hardware identifier are completely different from claim 16. First, in claim 16, the user identifier was generated based on the fingerprint file. However, Klein does not generate a user identifier based on its hardware identifier code. Instead, Klein creates an encryption key. Second, Klein's hardware identifier code is part of an encryption process local to a personal computer. Thus, Klein does not teach or

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[2] Final Office Action at page 2.
[3] Final Office Action citing Archibald at column 6, line 40.
[4] Archibald at column 6, lines 39-40.
[5] Office Action at page 3.

suggest receiving a fingerprint file from a remotely located computer. Third, Klein's hardware identifier code is not used to verify, over a network, a computer involved in an electronic commerce transaction. Instead, Klein's hardware identifier code is used to create an encryption key used in encrypting locally stored data on a storage device.

Applicant also submits that the Office Action does not provide detailed reasoning about why one of ordinary skill in the art would combine or modify the teachings of Padgett, Archibald, and Klein. Archibald's system is designed to track remote software program use, not verify a computer and user, while Klein's system encrypts locally stored information. Padgett is related to verifying a document's source. Because each reference deals with different technical subject matter, it is unclear how one of ordinary skill would combine the systems to work together. Without such detailed reasoning, it appears the Examiner has engaged in an impermissible hindsight analysis.

Based on the foregoing discussion, Applicant submits that the combination of Padgett, Archibald, and Klein does not teach or suggest all the elements of claim. Thus, Applicant submits claim 16 is allowable over the cited references. Claims 34-39 are rejected for similar reasons. Thus, Applicant submits that claims 34-39 are allowable for at least the reasons noted above.

The Examiner is invited to telephone Applicant's attorney Andrew DeLizio at 281-758-0025 to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No.

Respectfully submitted,

DeLizio Gilliam, PLLC
15201 Mason Road
Suite 1000-312
Cypress, TX 77433
281-758-0025

Date 4/12/2010 By /Andrew DeLizio Reg. #52,806/
Andrew DeLizio
Reg. No. 52,806